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09/892,857

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Kenji Kogure

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STAAS & HALSEY LLP

SUITE 700

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WASHINGTON, DC 20005

EXAMINER

PASS, NATALIE

ART UNIT

PAPER NUMBER

3626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/19/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

09/892,857

**Applicant(s)**

KOGURE, KENJI

**Examiner**

Natalie A. Pass

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-11,13-26 and 28-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-11,13-26 and 28-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Notice to Applicant***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 18 January 2007 has been entered.
2. This communication is in response to the Request for Continued Examination and amendment filed on 18 January 2007. Claims 2, 12, 27 have been previously cancelled. Claims 1, 9, 11, 23, 26, 34, 36 have been amended. Claims 1, 3-11, 13-26, 28-36 remain pending.

### ***Claim Objections***

3. Applicant is advised that should claims 13, 16 be found allowable, claims 15, 19 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claim 1, 9, 11, 23, 26, 34, 36 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Claims 1, 9, 11, 23, 26, 34, 36 recite limitations that are new matter, and are therefore rejected. The added material which is not supported by the original disclosure is as follows:

- "common to all customers," in claims 1, 9, 11, 23, 26, 34, 36, at lines 10, 8-9, 8, 7, 11, 9-10, 7, respectively
- "deriving registration data," as disclosed in claim 36 at line 4;
- "merging the derived registration data with at least a name," as disclosed in claim 36 at line 6;
- "merged registration data," as disclosed in claim 36 at line 10.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

- a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and
- b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

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In particular, the Examiner was unable able to find any support for this newly added language within the specification as originally filed on 28 June 2001. Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

6. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 28 June 2001.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

8. Claims 1, 3-11, 13-26, 28-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Silverbrook et al, U.S. Patent Number 6, 959, 298 for substantially the same reasons given in the previous Office Action (paper number 20060930). Further reasons appear hereinbelow.

(A) Claims 1, 9, 11, 23, 26, 34, 36 have been amended to include the recitation of

- ♦ "[...] via an input device common to all customers [...]," at lines 10, 8-9, 8, 7, 11, 9-10, 7, respectively.

As per newly amended claim 11, Silverbrook teaches an automated contract engaging method in which a group of customers being a first party and having common personal data except at least name engages a single collective contract or a plurality of individual contracts with a second party on an automated contract engaging apparatus including a display, said method comprising:

inputting the personal data of a representative customer of the group as first registration data (Silverbrook; Figure 21, column 47, lines 27-28);

inputting at least the name of each of the remaining customers of the group as second registration data (Silverbrook; Figure 51, Figure 81, Figure 82, Figure 84, column 48, line 1) via an input device common to all customers (Silverbrook; Figure 81, column 8, lines 3-10, 8-20);

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Examiner interprets Silverbrook's teachings of interactive input screens or "the netpage system relies ... [...] ... human interaction with, netpages. These are pages of text, graphics and images ... [...] ... which work like interactive web pages" (Silverbrook; column 8, lines 4-6) to teach a form of inputting registration data via an input device common to all customers;

processing and executing the single collective contract or the individual contracts with respect to the plural customers based on said first registration data input in the inputting the personal data step and said second registration data input in the inputting at least the name step (Silverbrook; Figure 51, Figure 82, Figure 84, column 47, line 61 to column 48, line 2, column 50, lines 50-54); and

inputting the common personal data of the remaining customers of the group using part of said first registration data which part is common to the group (Silverbrook; Figure 63, Figure 65, Figure 81, column 47, line 67 to column 48, line 1, column 49, lines 6-13, column 50, lines 44-60).

(B) Claim 23 differs from claim 11 in that claim 11 recites "having common personal data except at least name" in the preamble, while claim 23 does not.

As per newly amended claim 23, Silverbrook teaches a an automated contract engaging method in which a group of customers being a first party engages a single collective contract or a plurality of individual contracts with a second party on an automated contract engaging apparatus including a display, said method comprising:

inputting the personal data of a representative customer of the group as first registration data (Silverbrook; Figure 21, column 47, lines 27-28);

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inputting at least the number of customers remaining in the group as second registration data (Silverbrook; column 30, lines 44-54) via an input device common to all customers (Silverbrook; Figure 81, column 8, lines 3-10, 8-20); Examiner interprets Silverbrook's teachings of interactive input screens or "the netpage system relies ... [...] ... human interaction with, netpages. These are pages of text, graphics and images ... [...] ... which work like interactive web pages" (Silverbrook; column 8, lines 4-6) to teach a form of inputting registration data via an input device common to all customers; and

processing and executing the single collective contract or the individual contracts with respect to the plural customers based on said first registration data input in the inputting the personal data step and said second registration data input in the inputting at least the number step (Silverbrook; Figure 51, Figure 82, Figure 84, column 47, line 61 to column 48, line 2, column 50, lines 50-54).

(C) As per claims 13-22, 24-25 Silverbrook teaches a method as analyzed and discussed in claims 11 and 23 above

wherein said first registration data is input through a "form" and a "sensing device" (reads on "primary input screen image shown on the display") in the inputting the personal data step (Silverbrook; Figure 81, column 2, lines 45-59); and said second registration data is input through an "interactive form" (reads on "auxiliary input screen image shown on the screen of the display") in the inputting at least the name step (Silverbrook; Figure 1, Figure 82, column 8, lines 3-22, column 48, line 1);

wherein the part of said first registration data is input as part of the personal data of the remaining customers of the group in response to the instructions of a "netpage pen" (reads on



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“input assisting actuator associated with the display of the apparatus”) (Silverbrook; column 8, lines 3-22);

further comprising “changing” (reads on “switching”) the “[net]page ID” (reads on “screen images on the screen of the display from said primary input screen image to said auxiliary input screen image”) (Silverbrook; Figure 1, column 20, lines 2-5) in response to the instructions of a “netpage pen” (reads on “screen image switch”) associated with the display (Silverbrook; Figure 1, column 20, lines 2-5); and

wherein the common personal data of said first registration data to be input as part of the personal data of the remaining customers is a family name of the representative customer if the group is a family (Silverbrook; Figure 63, column 9, lines 34-36).

(D) Claims 26, 28-33 differ from method claims 11, 16, 14, 16, 17, 16, 16 respectively by reciting a “computer readable recording medium which records an automated contract engaging program ...” in the preamble.

As per this limitation, Silverbrook clearly discloses “receiving, in a computer system, data from a sensing device” and “interpreting, in the computer system, said movement of the sensing device as it relates to said at least one parameter” (Silverbrook; column 2, lines 42-59). As such, Silverbrook implicitly includes computer elements such as a computer readable recording medium and a display controller and a contract processor and a contract engaging program. The remainder of claims 26, 28-33 repeat the limitations of claims 11, 16, 14, 16, 17, 16, 16 respectively, and are therefore rejected for the same reasons given above for claims 11, 16, 14, 16, 17, 16, 16.

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(E) Claims 34-35 differ from method claims 23, 25 respectively by reciting “[a]n automated contract engaging program for instructing a computer ...” in the preamble.

As per this limitation, Silverbrook clearly discloses “receiving, in a computer system, data from a sensing device” and “interpreting, in the computer system, said movement of the sensing device as it relates to said at least one parameter” (Silverbrook; column 2, lines 42-59). As such, Silverbrook implicitly includes computer elements such as an automated contract engaging program for instructing a computer and a display controller and a contract processor. The remainder of claims 34-35 repeat the limitations of claims 23, 25 respectively, and are therefore rejected for the same reasons given above for claims 23, 25.

(F) Claims 1, 3-8 differ from method claims 11, 16, 14, 16, 17, 16, 16 respectively by reciting “[a]n automated contract engaging apparatus ...” in the preamble.

Apparatus claims 1, 3-8 repeat the subject matter of claims 11, 16, 14, 16, 17, 16, 16, respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 11, 16, 14, 16, 17, 16, 16 have been shown to be obvious in view of the teachings of Silverbrook in the above rejections of claims 11, 16, 14, 16, 17, 16, 16, it is readily apparent that the system disclosed by Silverbrook includes the apparatus to perform these functions. As such, these limitations are rejected of the same reasons given above for method claim 11, 16, 14, 16, 17, 16, 16, and incorporated herein.

(G) Claims 9-10 differ from method claims 23, 25 respectively by reciting “[a]n automated contract engaging apparatus ...” in the preamble.

Apparatus claims 9-10 repeat the subject matter of claims 23, 25 respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 23, 25 have been shown to be obvious in view of the teachings of Silverbrook in the above rejections of claims 23, 25, it is readily apparent that the system disclosed by Silverbrook includes the apparatus to perform these functions. As such, these limitations are rejected of the same reasons given above for method claim 23, 25, and incorporated herein.

(H) As per newly amended claim 36, Silverbrook teaches a method of engaging a group of customers having common personal data in a single collective contract or a plurality of individual contracts with another party, the method comprising:

deriving registration data which part is common to the group of customers, from registration data of a first customer (Silverbrook; Figure 51, Figure 63, Figure 81, column 47, line 66 to column 48, line 2, column 49, lines 6-13, column 50, lines 44-60);

merging the derived registration data with at least a name inputted for each remaining customers of the group (Silverbrook; Figure 51, Figure 63 to Figure 65, Figure 81 to Figure 84, column 47, line 66 to column 48, line 2, column 49, lines 6-13, column 50, lines 44-60) via an input device common to all customers (Silverbrook; Figure 81, column 8, lines 3-10, 8-20); Examiner interprets Silverbrook's teachings of interactive input screens or "the netpage system relies ... [...] ... human interaction with, netpages. These are pages of text, graphics and images ... [...] ... which work like interactive web pages" (Silverbrook; column 8, lines 4-6) to teach a form of inputting registration data via an input device common to all customers; and

processing and executing the single collective contract or the individual contracts with respect to the group of customers based on the registration data of the first customer and the

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merged registration data of the remaining customers of the group (Silverbrook; Figure 51, Figure 63 to Figure 65, Figure 81 to Figure 84, column 47, line 66 to column 48, line 2, column 49, lines 6-13, column 50, lines 44-60).

### ***Response to Arguments***

9. Applicant's arguments filed 18 January 2007 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 18 January 2007.

(A) At page 10, paragraph 2 of the 18 January 2007 response Applicant seeks clarification of phraseology used by Examiner in the "Response to Arguments" section of the previous Office Action (paper number 20060930). Examiner thanks Applicant for pointing out the unclear language, and would like to clarify that, as the rejection has been based on 35 U.S.C. 102(e), it is the anticipation standard that has been applied.

(B) At pages 10-11 of the 18 January 2007 response, Applicant argues that the features in the Application are not taught or suggested by the applied reference. In response, all of the limitations which Applicant disputes as missing in the applied references have been fully addressed by the Examiner as being fully disclosed in view of the teachings of Silverbrook, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 20060930), and incorporated herein. Specifically, Examiner notes that the recited features of "inputting the personal data of a

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representative customer of the group as first registration data” and “inputting the common personal data of the remaining customers of the group using part of said first registration data which part is common to the group” are taught by the applied reference. In particular, Examiner interprets Silverbrook’s teaching of “[e]ach policy covers one or more travelers” (Silverbrook; column 47, line 66 to column 48, line 2) together with Silverbrook’s interactive input forms such as the “Travel Insurance Inquiry” form of Figure 81, and the “Passenger Details” form of Figure 63, that request “user name” or “family name” or “last name” for a first passenger or user to teach inputting the personal data of a “representative customer” of the group as first registration data, and Examiner interprets Silverbrook’s teachings of interactive input forms such as the “Travel Insurance Inquiry” form of Figure 81, and the “Passenger Details” form of Figure 63, that request information for second and third “users” or “passengers,” together with the travel insurance class diagram schematic of Figure 51, to teach inputting the common personal data of the remaining customers of the group using part of said first registration data which part is common to the group.

With respect to Applicant’s assertion at paragraph 3 at page 10 of the 18 January 2007 response that “in contrast, the present claims are directed to a system for inputting data for a group into electronic insurance forms,” Examiner respectfully notes that this is not a claimed limitation. Nevertheless, Examiner notes that Silverbrook teaches that “[t]he ... [...] ... system provides efficient mechanisms for airlines or travel companies to offer products and services to customers. Travel services can include enquiries about and reservations of flights ... [...] ... and travel insurance” (emphasis added) (Silverbrook; column 46, lines 32-36) and “[e]ach [insurance] policy covers one or more travelers” (Silverbrook; column 47, line 66 to column 48,

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line 2), and furthermore, Examiner notes that Figures 81 and 82 of the Silberbrook reference also incorporate insurance for a group of travelers.

As per Applicant's allegation at page 10 of the 18 January 2007 response that the Silberbrook reference teaches away from inputting information based on common information, Examiner respectfully disagrees. Although, as pointed out by Applicant, one embodiment of Silberbrook "allows each user to maintain a distinct profile", i.e. Silberbrook teaches that "[a] netpage printer can be configured to support any number of pens, and a pen can work with any number of netpage printers. In the preferred implementation, each netpage pen has a unique identifier. A household may have a collection of colored netpage pens, one assigned to each member of the family. This allows each user to maintain a distinct profile with respect to a netpage publication server or application server" (emphasis added) (Silverbrook; column 9, lines 31-37), Silberbrook also teaches "[a]s illustrated in FIG. 1, a printed netpage 1 can represent an interactive form which can be filled in by the user both physically, on the printed page, and "electronically", via communication between the pen and the netpage system" (Silverbrook; column 8, lines 20-23) and Silberbrook teaches "[a] netpage pen can also be registered with a netpage registration server 11 and linked to one or more payment card accounts. This allows e-commerce payments to be securely authorized using the netpage pen" (Silverbrook; column 9, lines 39-42). As detailed above, and throughout the Silberbrook reference, Silberbrook teaches a variety of inputting embodiments. Examiner interprets the various embodiments of Silberbrook to not teach away from inputting based on common attributes of a group, as Examiner interprets "household" to be a form of group and Examiner notes that user profiles of group members are not precluded from including common attributes of that user's group.

As per applicant's arguments in the first paragraph on page 11, these issues have been previously addressed in this Office Action.

With respect to Applicant's argument at paragraph 2 on page 11 of the 18 January 2007 response that the Silverbrook reference does not disclose "an input device common to all customers," as recited in amended claims 1, 9, 11, 23, 26, 34, 36, Examiner respectfully disagrees. Examiner interprets Silverbrook's interactive input forms such as the "Travel Insurance Inquiry" form of Figure 81, and the "Passenger Details" form of Figure 63, which work like interactive web pages, to be a form of an input device common to all customers.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references, Kalmes et al., 6934715, Newman, 2002/0103680, Brophy et al., 2002/0069077, Brody, 2001/0051928, Kern, 6604080, Schoen et al., 6235176, Gamble, et al., 6163770, Gamble, et al., 6014632 teach the environment of automatically generating contracts.

11. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington D.C. 20231**

or faxed to: **(571) 273-8300.**

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For informal or draft communications, please label  
"PROPOSED" or "DRAFT" on the front page of the communication  
and do NOT sign the communication.

After Final communications should be labeled "Box AF."

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Natalie A. Pass

April 12, 2007

*Carolyn Bleck*  
Patent Examiner-3626  
4/16/07